

Applicants: Mehta *et al.*  
U.S.S.N. 09/351,617

subject matter of the cancelled claims in a future application or applications. No new matter has been added by these amendments.

The Examiner requested in the Restriction Requirement that Applicants elect a single species from Items 2A, 2B, 2C and 2D. Items 2A and 2B pertain to now canceled claim 2 and claim 3. With the foregoing amendment canceling claims 2-3, plus claims 4-5 and 7-11, which depend therefrom, Applicants submit that the requirement to elect a single species from each of Items 2A and 2B is moot, and Applicants request that the species election requirement pertaining to Items 2A and 2B be withdrawn. OK

Applicants have elected a single species comprising the combinatorial library of small organic molecules (claim 22) in Item 2C, as noted above. No claims depend from claim 22. OK

Applicants traverse the species election required by the Examiner in Item 2D. Applicants have elected to provisionally cancel claim 25. Claim 25 should not be canceled if the following arguments for traverse are persuasive and the species election requirement is withdrawn.

Claim 25 is a Markush-type claim listing several genes commonly used in the art as alternative "reporter gene(s)", defined in the specification on page 8, lines 1-3, as "marker(s) for detecting the formation of a hybrid complex." The 1997 BioSupplyNet Source Book ("Exhibit 1"), on pages 40 and 213, lists reporter genes commercially available by at least 1997. Exhibit 1 provides at least  $\beta$ -galactosidase (LAC-Z), Fluorescent Green Protein (FGP), luciferase, and immunodetection kits as alternative reporters for detecting experimental outcomes. The list in Exhibit 1 includes many of the same species that are listed in claim 25. Applicants submit that it would be obvious to a person skilled in the art that any one of these species may be substituted as a reporter gene in the instant invention.

Claim 25 without amendment should be examined on its merits. Claim 25 recites relatively few members of a Markush group which are closely related and share a common utility, as indicated in the specification and in Exhibit 1. The MPEP teaches that "[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims of the merits, even though they are directed to independent and distinct inventions." MPEP § 803.02, first paragraph. Accordingly, claim 25 is the type of Markush claim that should be examined on its merits and should not be subject to a species election. but not same properties search is not for claim

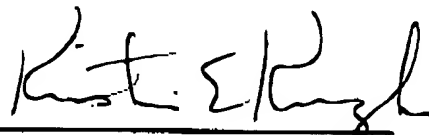
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Additionally, MPEP § 803.02, third paragraph, teaches examiners that the only time a species election is proper in a Markush claim is if "two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s)." The reporter genes recited in claim 25 are not sufficiently unrelated and diverse to render a species election proper. For the above reasons, Applicants request that the species election requirement for claim 25 in Item 2D of the Restriction Requirement be withdrawn.

### CONCLUSION

In view of the foregoing, Applicant submits that the application is in condition for allowance and such action is respectfully requested. Should any questions or issues arise concerning the application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



Ivor R. Elrifi, Reg. No. 39,529  
Kristin E. Konzak, Reg. No. 44,848  
Attorney/Agent for Applicants  
c/o MINTZ, LEVIN  
One Financial Center  
Boston, Massachusetts 02111  
Tel: (617) 542-6000  
Fax: (617) 542-2241

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